In Re Application of:

Simpson, et al.

Serial No.: 10/021,340

Filed: December 13, 2001

Group Art Unit: 2625

Examiner: Murphy, Dillon

Docket No. 10008222-1

For: **System and Method for Form Processing Using a Printing Device**

<u>**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**</u>

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed February 20, 2007, responding to the Final Office Action mailed November 17, 2006.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-10 have been canceled leaving claims 11-27 remaining. Each of those claims stand finally rejected. No claims have been allowed. The final rejections of claims 11-27 are appealed.

IV. Status of Amendments

This application was originally filed on December 13, 2001, with twenty-seven (27) claims. In a Response filed September 22, 2005, Applicant amended claims 1, 2, 4-11, 13-15, 17-19, 22-24, and canceled claim 3. In a Response filed February 9, 2006, Applicant amended claims 1, 4, 5, 7, 8, 10, 11, 19, and 24. In a Response filed August

14, 2006, Applicant amended claims 11, 13, 14, 17, 18, 19, 22-27, and canceled claims 1-10.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 11-27. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 11 describes a method practiced by a printer for printing a form. The method comprises accessing form imaging data from at least one store via a network with the printer. *Applicant's specification*, page 24, lines 18-24; Figure 9A, item 904. The method of claim 11 further comprises retrieving the form imaging data from the at least one store with the printer. *Applicant's specification*, page 25, lines 1-2; Figure 9A, item 906. The method of claim 11 further comprises merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form. *Applicant's specification*, page 15, lines 1-7. The method of claim 11 further comprises printing the form imaging data along with the already stored static form data together as a hard copy form (*Applicant's specification*, page 25, lines 6-8; Figure 9, item 912), such that printing a hard copy form is possible without the need to

send the static form data to the printer and such that a copy of the static form data need only be stored on the printer.

Independent claim 19 describes a system stored on a printer for printing a form. The system comprises means (318, Figure 3) provided on the printer for accessing form imaging data from at least one store via a network. *Applicant's specification*, page 24, lines 18-24; Figure 9A, item 904. The system of claim 19 further comprises means (318, Figure 3) provided on the printer for retrieving the form imaging data from the at least one store. *Applicant's specification*, page 25, lines 1-2; Figure 9A, item 906. The system of claim 19 further comprises means (318, Figure 3) for merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form. *Applicant's specification*, page 15, lines 1-7. The system of claim 19 further comprises means (318, Figure 3) for printing the form imaging data along with the already stored static form data together as a hard copy form (*Applicant's specification*, page 25, lines 6-8; Figure 9, item 912), wherein printing a hard copy form is possible with the system without the need to send the static form data to the printer and wherein a copy of the static form data need only be stored on the printer.

Independent claim 24 describes a printer. The printer comprises memory (302, Figure 3) including logic (318, Figure 3) configured to access form imaging data from at least one store via a network, retrieve the form imaging data (*Applicant's specification*, page 24, lines 18-24; Figure 9A, item 904), merge the received data with static form data already stored on the printer to generate a completed form (*Applicant's specification*, page 15, lines 1-7), and print the form imaging data along with the already stored static form data together as a hard copy form (*Applicant's specification*, page 25, lines 6-8;

Figure 9, item 912), wherein printing a hard copy form is possible with the printer without the need to send the static form data to the printer and wherein a copy of the static form data need only be stored on the printer.

VI. <u>Grounds of Rejection to be Reviewed on Appeal</u>

The following grounds of rejection are to be reviewed on appeal:

1. Claims 11-13, 15, 19, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein* (U.S. Pat. No. 5,809,167) and *Lo et al.* ("Lo," U.S. Pat. No. 6,268,927).

2. Claims 14, 16-18, 20-23, 26, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein, Lo, LeClair et al.* (LeClair," U.S. Pat. No. 6,636,891), and *Pennell et al.* ("Pennell," U.S. Pat. No. 6,910,179).

VII. Arguments

The Appellant respectfully submits that Applicant's claims are not anticipated under 35 U.S.C. § 103, and respectfully requests that the Board of Patent Appeals overturn the final rejections of those claims at least for the reasons discussed below.

Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 11-13, 15, 19, 24, and 25

Claims 11-13, 15, 19, 24, and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein* (U.S. Pat. No. 5,809,167) and *Lo et al.* ("Lo," U.S. Pat. No. 6,268,927). Applicant respectfully traverses this rejection.

1. The Al-Hussein Disclosure

Al-Hussein discloses a stand-alone "personal imaging computer system." *Al-Hussein*, column 5, lines 6-10. As described by Al-Hussein, the system takes the form of PICS equipment 20, which essentially comprises a facsimile machine having the capabilities of a computer. *Al-Hussein*, column 5, lines 23-38.

Notably, Al-Hussein's PICS equipment 20 is not described as a "printer". Al-Hussein does, however, identify printers 45 and 56.

2. The Lo Disclosure

Lo discloses a computer-related form overlay method in which a printer 1 includes a mass storage device 3 that stores forms to which user data can be added so as to enable printing of a composite image. *Lo*, column 5, line 13 to column 6, line 2.

3.   Applicant's Claims

(a)   Claims 11-13 and 15

Applicant's claim 11 provides as follows (emphasis added):

11.   A method practiced by a printer for printing a form, the method comprising:

accessing form imaging data from at least one store via a network with the printer;

retrieving the form imaging data from the at least one store with the printer;

merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form; and

printing the form imaging data along with the already stored static form data together as a hard copy form, such that printing a hard copy form is possible without the need to send the static form data to the printer and such that a copy of the static form data need only be stored on the printer.

(i)   Al-Hussein's "PICS Equipment 20"

As an initial matter regarding claim 11, the Examiner argues that Al-Hussein teaches a method "practiced by a printer" on page 2 of the final Office Action. For support, the Examiner argues that "actions are performed *by the printer itself*, which comprises a general purpose computer". This is clearly not true. Column 5, lines 53-60 of the Al-Hussein reference, which the Examiner relies upon for the above statement, provides:

PICS equipment 20 includes a general purpose computer (described in further detail in FIG. 5) whereby an operator is able to scan in documents, segmentation-process and recognition-process the documents to create text files corresponding to text areas in the documents, print out document

images, manipulate document images and text files via trackball 36 and display screen 35, and send and receive documents and images via facsimile.

Al-Hussein, column 5, lines 53-60. As is clear from the above excerpt, it is Al-Hussein's "PICS equipment 20" and not any "printer" that Al-Hussein describes in column 5. As described above, the PICS equipment 20 essentially comprises a facsimile machine having the capabilities of a computer, and is not described as a "printer". That Al-Hussein's PICS equipment 20 is not a printer is underscored by the fact that Al-Hussein describes separate printers 45 and 56 that provide the printer functionality. *See Al-Hussein*, column 6, lines 16-25; column 6, lines 45-53; Fig. 4.

In the Advisory Action, the Examiner alleges that "[i]t seems that Applicant is finding fault in the PICS of Al-Hussein because the equipment 20 comprises a CPU #60, RAM Memory #79, and ROM #77, (which define a computer), in addition to a printer section #26." The Examiner has misconstrued Applicant's comments. Applicant does not object to citation of Al-Hussein's PICS equipment 20 because it comprises attributes of a computer. Instead, Applicant objects to the Examiner *treating the PICS equipment 20 as if it were a "printer"*. Again, the PICS equipment 20 is simply a facsimile machine that also has computing capabilities. That fact is clear both from Al-Hussein's explicit description of the equipment reproduced above and from Al-Hussein's Figure 3, which explicitly illustrates a typical facsimile machine. Clearly, such a device is not a "printer" as the term is well understood by persons having ordinary skill in the art. Furthermore, Al-Hussein does not describe the PICS equipment 20 as being used as a printer. For example, Al-Hussein does not describe transmitting print-ready documents from an application, such

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as Microsoft Word^{TM}, to the PICS equipment 20 for printing. Instead, such documents are transmitted to the printers that Al-Hussein *does* mention, i.e., printers 45 and 56. See, e.g., Figure 4.

Moreover, although the PICS equipment 20 is described as comprising a "printer section 26," that fact does *not* mean that the PICS equipment 20 *is* a "printer". Instead, the PICS equipment 20 simply comprises elements that can print scanned or faxed data, as any facsimile machine does. Applicant further notes that Al-Hussein does not describe the "printer section 26" of the PICS equipment 20 as performing the various actions claimed by Applicant. Therefore, Applicant reiterates that the Examiner has failed to identify a "printer" that performs the various actions of Applicant's claim 11.

(ii)   Claimed Actions Performed by a Printer

Turning to the various actions recited in claim 11, Applicant asserts that, contrary to the Examiner's arguments, Al-Hussein fails to teach a printer that performs the actions of "accessing form imaging data from at least one store via a network" and "retrieving the form imaging data from the at least one store". On page 3 of the final Office Action, the Examiner alleges that column 6, lines 22-25 of the Al-Hussein teaches the claimed "accessing" and "retrieving". That portion of Al-Hussein's disclosure provides as follows:

> . . . operators at one of the workstations 40 can scan in a document using PICS equipment 20, segmentation-process and recognition-process the document image so as to obtain a text file corresponding to text areas of the document, store the document image and associated text file on network disk 42, retrieve the document image and its associated text file for

> manipulation, if desired, at workstation 40, and print out the original or
> manipulated document image and text file on one of printers 45.

Al-Hussein, column 6, lines 16-25. As is abundantly clear from the above, Al-Hussein is describing *scanning a hard copy document* with the PICS equipment 20 and then transmitting the scanned file to the workstation 40 so that the file can be printed using one of the printers 45. Such "scanning" by the PICS equipment 20 can hardly be considered to comprise either of "accessing form imaging data from at least one store via a network" or "retrieving the form imaging data from the at least one store". Specifically, imaging data is accessed from a hard copy document, not from a "store". Furthermore, the imaging data is not accessed "via a network". Additionally, Al-Hussein's scanning cannot be said to comprise "retrieving" data from "the at least one store". Therefore, the Examiner has failed to identify a teaching or suggestion within the Al-Hussein reference of a printer that accesses and retrieves form imaging data from at least one store via a network.

On page 3 of the Advisory Action, the Examiner also cites column 6, lines 12-16 of the Al-Hussein reference as allegedly teaching a printer accessing form imaging data from a store via a network. That portion of the Al-Hussein disclosure provides:

> Also connected to local area network 31 is a file server 41 which manages
> access to files stored on network disk 42. A print server 44 provides print
> services to printers 45. Other unshown peripherals may be connected to
> local area network 31.

Al-Hussein, column 6, lines 12-16. As is clear from the above excerpt, Al-Hussein only describes a "file server 41" and a "print server 44" accessing files. Nothing in that excerpt describes a "printer" accessing any files.

Also on page 3 of the Advisory Action, the Examiner cites column 6, lines 2-4 for support. That portion of the Al-Hussein disclosure provides:

> When connected to a local area network 31 and/or a wide area network 32, PICS equipment 20 provides the capabilities described above to computerized network users.

Al-Hussein, column 6, lines 204. Clearly, that general disclosure does not teach a "printer" accessing or retrieving any data from a store via a network.

Further on page 3, the Examiner admits that the various "accessing" and "retrieving" described by Al-Hussein are performed by computers and not the PICS equipment 20, but appears to argue that the PICS equipment 20 also performs such functions because it comprises attributes of a computer. Applicant notes that the Examiner's conclusion is simply not supported by the Al-Hussein disclosure. Specifically, although Al-Hussein states that the PICS equipment 20 comprises attributes of a computer, *nowhere* does Al-Hussein state that the PICS equipment 20 does or can access and retrieve data from a store on a network. Given that the PICS equipment 20 is not a printer but a facsimile device, Applicant submits that is unlikely that the PICS equipment 20 is capable of such functionality. Regardless, without an actual teaching or suggestion provided by the prior art, the Examiner's cannot legitimately state that *the prior art* teaches or suggests Applicant's claimed accessing and retrieving.

(iii)   Combination of Al-Hussein and Lo

Given that, as described above, Al-Hussein's PICS equipment 20 is a facsimile machine and not a "printer", it would not have been obvious to combine the printing

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functionalities of the Lo printer, including storing form data and merging user data received from another computer with that form data to the PICS equipment. Specifically, given that the functionalities performed by dedicated facsimile machines are quite different from those provided by printers, a person having ordinary skill in the art simply would not think to attribute printer functionalities (like printing forms from print ready data received from a PC) to Al-Hussein's PICS equipment 20 when Al-Hussein so clearly is describing a dedicated facsimile machine and explicitly chose to include *separate* printers in his system to provide printing functionality. Applicant accordingly submits that the rejection is flawed as comprising an improper combination under 35 U.S.C. § 103. Indeed, it appears clear that the Examiner has considered each limitation of Applicant's claims in a vacuum. As is well established in the law, such a piecemeal approach is improper and the Examiner must instead consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed").

(b)   Claims 19, 24, and 25

Regarding independent claim 19, Applicant notes that neither Al-Hussein nor Lo teach or suggest "means provided on the printer for accessing form imaging data from at least one store via a network" or "means provided on the printer for retrieving the form imaging data from the at least one store" for reasons described above. Furthermore, there would have been no motivation to a person having ordinary skill in the art to add Lo's form

processing and printing functionalities to Al-Hussein's equipment 20, also for reasons described above. Accordingly, claim 19 is allowable over Al-Hussein and Lo.

Regarding independent claim 24, Applicant notes that neither Al-Hussein nor Lo teach or suggest a "printer" comprising "logic configured to access form imaging data from at least one store via a network, retrieve the form imaging data, merge the received data with static form data already stored on printer to generate a completed form, and print the form imaging data along with the already stored static form data together as a hard copy form" for reasons described in the foregoing. Accordingly, claims 24 and 25 are allowable over Al-Hussein and Lo.

B.   Rejection of Claims 14, 16-18, 20-23, 26, and 27

Claims 14, 16-18, 20-23, 26, and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Al-Hussein, Lo, LeClair et al.* (LeClair," U.S. Pat. No. 6,636,891), and *Pennell et al.* ("Pennell," U.S. Pat. No. 6,910,179). Applicant respectfully traverses this rejection.

As is identified above, Al-Hussein and Lo do not teach aspects of Applicant's independent claims 11, 19, and 24. In that the LeClair and Pennell references do not remedy the deficiencies of the Al-Hussein and Lo references, Applicant respectfully submits that claims 14, 16-18, 20-23, 26, and 27 are for at least the same reasons that claims 11, 19, and 24 are allowable over Al-Hussein/Lo.

With particular regard to dependent claim 16, the references do not teach or suggest an "imaging extension" that "comprises part of a user browser" that accesses imaging data. In response to the Examiner's identification of column 8, lines 1-3 of the

LeClair reference, LeClair's general reference to invoking a browser to "submit information" is not a teaching of an "imaging extension" of a browser "accessing" imaging data "from at least one store via a network" (see claim 11).

Regarding dependent claims 17 and 18, the references do not teach or suggest an "imaging extension" that "comprises part of a network-based printing service hosted by the printer" that accesses imaging data. In response to the Examiner's identification of column 7, lines 57-65 and column 8, lines 1-3 of the LeClair reference, LeClair's general reference to an embedded server and invoking a browser to "submit information" is not a teaching of an "imaging extension" of a network-based printing service "hosted by the printer" "accessing" imaging data "from at least one store via a network" (see claim 11).

Regarding dependent claims 21, 22, 23, Applicant refers to the discussion of claims 16, 17, and 18, respectively.
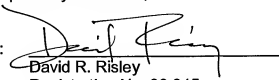
Regarding dependent claim 27, Applicant refers to the discussion of claims 17 and 18.

VIII. <u>Conclusion</u>

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By: _____

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<u>**Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)**</u>

The following are the claims that are involved in this Appeal.

1-10.   (Canceled)

11.   A method practiced by a printer for printing a form, the method comprising:

accessing form imaging data from at least one store via a network with the printer;

retrieving the form imaging data from the at least one store with the printer;

merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form; and

printing the form imaging data along with the already stored static form data together as a hard copy form, such that printing a hard copy form is possible without the need to send the static form data to the printer and such that a copy of the static form data need only be stored on the printer.

12.   The method of claim 11, wherein the at least one store comprises a graphic store and a composition store.

13.   The method of claim 11, wherein the at least one store is associated with an imaging service stored on the printer that is configured to facilitate form completion.

14.   The method of claim 13, wherein the imaging service comprises a network-based form processing service hosted by the printer.

15. The method of claim 11, wherein accessing form imaging data comprises accessing imaging data through use of an imaging extension.

16. The method of claim 15, wherein the imaging extension comprises part of a user browser.

17. The method of claim 15, wherein the imaging extension comprises part of a network-based printing service hosted by the printer.

18. The method of claim 17, wherein the printing service is hosted by an embedded server of the printer.

19. A system stored on a printer for printing a form, the system comprising:

means provided on the printer for accessing form imaging data from at least one store via a network;

means provided on the printer for retrieving the form imaging data from the at least one store;

means for merging the retrieved form imaging data with static form data already stored on the printer to generate a completed form; and

means for printing the form imaging data along with the already stored static form data together as a hard copy form;

wherein printing a hard copy form is possible with the system without the need to send the static form data to the printer and wherein a copy of the static form data need only be stored on the printer.

20.   The system of claim 19, wherein the means for accessing form imaging data comprises an imaging extension.

21.   The system of claim 20, wherein the imaging extension comprises part of a user browser.

22.   The system of claim 20, wherein the imaging extension comprises part of a network-based printing service hosted by the printer.

23.   The system of claim 22, wherein the printing service is hosted by an embedded server of the printer.

24.   A printer, comprising:

memory including logic configured to access form imaging data from at least one store via a network, retrieve the form imaging data, merge the received data with static form data already stored on the printer to generate a completed form, and print the form imaging data along with the already stored static form data together as a hard copy form;

wherein printing a hard copy form is possible with the printer without the need to send the static form data to the printer and wherein a copy of the static form data need only be stored on the printer.

25.   The printer of claim 24, wherein the logic comprises a network-based printing service.

26.   The printer of claim 24, wherein the logic comprises an imaging extension that is configured to access the at least one store.

27.   The printer of claim 24, further comprising an embedded server.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

<u>Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)</u>

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.